

ESTTA Tracking number: **ESTTA539709**

Filing date: **05/23/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209747
Party	Plaintiff Rita M. Clark d/b/a Bluewater Rentals
Correspondence Address	MICHAEL DE BIASE BECKER & POLIAKOFF PA 3111 STIRLING ROAD FT. LAUDERDALE, FL 33312 UNITED STATES mdebiase@becker-poliakoff.com
Submission	Answer to Counterclaim
Filer's Name	Michael N. De Biase
Filer's e-mail	mdebiase@becker-poliakoff.com
Signature	/michael n debiase/
Date	05/23/2013
Attachments	4742587_1.pdf(43753 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85644802
Published in the Official Gazette on November 13, 2012
Mark: Bluewater Key
International Class: 43

CLARK, RITA M. d/b/a
BLUEWATER RENTALS

Opposer,

Opposition No.91209747

v.

BLUEWATER KEY RV OWNERSHIP
PARK PROPERTY OWNERS
ASSOCIATION, INC.,

Applicant.

**OPPOSER'S ANSWER AND AFFIRMATIVE DEFENSES
TO APPLICANT'S COUNTERCLAIM FOR PETITION TO CANCEL**

Opposer and Respondent, Rita M. Clark d/b/a Bluewater Rentals ("Opposer") filed a Notice of Opposition on March 13, 2013 to oppose the registration of the trademark BLUEWATER KEY, Application Serial No. 85644802. Subsequently, Applicant and Petitioner, Bluewater Key RV Ownership Park Property Owners Association, Inc. ("Applicant") filed its Answer to Notice of Opposition and Counterclaim for Petition to Cancel Opposer's BLUEWATER RENTALS trademark registration, Registration No. 4,274,836.

In response to Applicant's Counterclaim, by and through the undersigned counsel, Opposer files this Answer and Affirmative Defenses, and states as follows:

29. Admitted.

30. Opposer is without knowledge of the allegations contained in Paragraph 30 of Applicant's Counterclaim and therefore denies same.

31. Denied.

32. Admitted.

33. Denied.

34. Opposer is without knowledge of the allegations contained in Paragraph 34 of Applicant's Counterclaim and therefore denies same.

35. Opposer is without knowledge of the allegations contained in Paragraph 35 of Applicant's Counterclaim and therefore denies same.

36. Denied.

37. Opposer cannot decipher Applicant's allegations contained in Paragraph 37 of Applicant's Counterclaim and therefore can neither admit nor deny.

38. Admitted.

39. Opposer is without knowledge of the allegations contained in Paragraph 39 of Applicant's Counterclaim and therefore denies same.

40. Opposer is without knowledge of the allegations contained in Paragraph 40 of Applicant's Counterclaim and therefore denies same.

41. Denied as to Applicant's user of the term Bluewater Key as a trade name. Upon information and belief, the remaining allegations in Paragraph 41 of Applicant's Counterclaim are admitted.

42. Opposer is without knowledge of the allegations contained in Paragraph 42 of Applicant's Counterclaim and therefore denies same.

43. Opposer is without knowledge of the allegations contained in Paragraph 43 of Applicant's Counterclaim and therefore denies same.

44. Denied.

45. Opposer is without knowledge of the allegations contained in Paragraph 45 of Applicant's Counterclaim and therefore denies same.

46. Opposer is without knowledge of the remaining allegations contained in Paragraph 46 of Applicant's Counterclaim and therefore denies same.

47. Denied.

48. Denied.

49. Opposer admits that it received the document packet, but is without knowledge of the remaining allegations in Paragraph 49 of Applicant's Counterclaim and therefore denies same.

50. Denied.

51. Opposer is without knowledge of the allegations contained in Paragraph 51 of Applicant's Counterclaim and therefore denies same.

52. Opposer is without knowledge of the allegations contained in Paragraph 52 of Applicant's Counterclaim and therefore denies same.

53. Admitted that Applicant has attached a drawing. Opposer is without knowledge of the remaining allegations contained in Paragraph 53 of Applicant's Counterclaim and therefore denies same.

54. Opposer is without knowledge of the allegations contained in Paragraph 54 of Applicant's Counterclaim and therefore denies same.

55. Denied.

56. Denied.

57. Admitted that Applicant has provided copies of current advertisements and other documents as Exhibits to its Counterclaim. Denied as to the remaining allegations in Paragraph 57 of Applicant's Counterclaim.

58. Denied.

59. Denied.

60. Denied.

61. Denied.

62. Denied

63. Denied.

64. Denied.

65. Denied.

66. Denied.

67. Denied.

68. Opposer neither admits nor denies the allegations in Paragraph 68 of Applicant's Counterclaim; the documents speak for themselves. Opposer denies any interpretation by Applicant, or effort to vary the terms of such documents.

69. Denied.

70. Admitted.

71. Denied.

72. Admitted that management of Applicant was transferred from Lloyd A. Good to the Owners. Denied as to the remaining allegations in Paragraph 72 of Applicant's Counterclaim.

73. Opposer is without knowledge of the allegations contained in Paragraph 73 of Applicant's Counterclaim and therefore denies same.

74. Opposer is without knowledge of the allegations contained in Paragraph 74 of Applicant's Counterclaim and therefore denies same.

75. Denied.

76. Denied.

77. Opposer is without knowledge of the allegations contained in Paragraph 77 of Applicant's Counterclaim and therefore denies same.

78. Denied.

79. Denied.

80. Denied.

81. Denied.

82. Denied.

83. Opposer is without knowledge of the allegations contained in Paragraph 83 of Applicant's Counterclaim and therefore denies same.

84. Denied.

85. Denied.

86. Admitted.

87. Admitted.

88. Admitted.

89. Admitted.

90. Opposer is without knowledge of the allegations contained in Paragraph 90 of Applicant's Counterclaim and therefore denies same.

91. Denied.

92. Opposer is without knowledge of the allegations contained in Paragraph 92 of Applicant's Counterclaim and therefore denies same.

93. Opposer is without knowledge of the allegations contained in Paragraph 93 of Applicant's Counterclaim and therefore denies same.

94. Opposer is without knowledge of the allegations contained in Paragraph 94 of Applicant's Counterclaim and therefore denies same.

95. Admitted that Applicant distributed a Newsletter. Denied as to the remaining allegations contained in Paragraph 95 of Applicant's Counterclaim.

96. Admitted that Rita Clark began a rental program. Denied as to the remaining allegations contained in Paragraph 96 of Applicant's Counterclaim.

97. Admitted.

98. Admitted.

99. Opposer is without knowledge of the allegations contained in Paragraph 99 of Applicant's Counterclaim and therefore denies same.

100. Denied as to Applicant's allegation that Opposer's conduct is probative evidence of Opposer's bad faith. Admitted as to the remaining allegations in Paragraph 100 of Applicant's Counterclaim.

101. Denied.

102. Denied.

103. Denied.

104. Admitted.

105. Opposer is unable to decipher Applicant's allegation in Paragraph 105 of Applicant's Counterclaim and therefore can neither admit nor deny same.

106. Admitted.

107. Opposer is without knowledge of the allegations contained in Paragraph 107 of Applicant's Counterclaim and therefore denies same.

108. Admitted.

109. Opposer is without knowledge of the allegations contained in Paragraph 109 of Applicant's Counterclaim and therefore denies same.

110. Opposer is without knowledge of the allegations contained in Paragraph 110 of Applicant's Counterclaim and therefore denies same.

111. Denied.

112. Denied.

113. Denied.

114. Denied.

115. Denied.

116. Denied.

117. Denied.

118. Denied.

119. Admitted that Applicant has petitioned to cancel Opposer's mark. Denied as to the remaining allegations contained in Paragraph 119 of Applicant's Counterclaim.

120. Admitted.

121. Admitted.

122. Opposer is without knowledge of the allegations contained in Paragraph 122 of Applicant's Counterclaim and therefore denies same.

123. Admitted.

124. Opposer is without knowledge of the allegations contained in Paragraph 124 of Applicant's Counterclaim and therefore denies same.

125. Opposer is without knowledge of the allegations contained in Paragraph 125 of Applicant's Counterclaim and therefore denies same.

AFFIRMATIVE DEFENSES

First Affirmative Defense

Opposer's use of the term "Bluewater Key" qualifies as fair use.

Second Affirmative Defense

Applicant has waived the claims alleged in their Counterclaim through knowingly and intentionally allowing Opposer to use the terms "Bluewater Key", "Bluewater Rentals", and other derivations thereof, in commerce for over fourteen years, to conduct rental and leasing services. The rental and leasing services conducted by Opposer included, among other things, the renting and leasing of RV lots in the Bluewater Key community, during which time Applicant collected a fee from Opposer. Applicant knew of Opposer's trademark application for the BLUEWATER RENTALS mark, but failed to oppose the application. Rather, it is only now, after over fourteen years that Applicant objects to Opposer's use of the Bluewater terms, in bad faith, due to Opposer's opposition of Applicant's application.

Third Affirmative Defense

Applicant is estopped from recovery because Applicant has represented through its words and conduct that Opposer had the right to use the Bluewater terms for Opposer's rental and leasing services business. Opposer's use of the Bluewater terms continued uninterrupted and without objection by Applicant for over fourteen years. Opposer has relied on its use of the Bluewater terms, and Applicant's consent to same, to build a business by which consumers know Opposer through the use of the BLUEWATER RENTALS mark. With full knowledge of these facts, Applicant has wrongfully filed its Counterclaim and Application in this matter. Facts further supporting this defense are included in Opposer's Notice of Opposition.

Fourth Affirmative Defense

Applicants have acquiesced and accepted Opposer's use of the Bluewater terms and marks, with full knowledge thereof, and have reaped financial benefits from same. Applicant's conduct in this regard demonstrates active ratification, endorsement, and encouragement of Opposer's use of the Bluewater terms.

Fifth Affirmative Defense

Applicant's claims are barred under the Doctrine of Laches.

Sixth Affirmative Defense

Applicant's Claims are barred due to Applicant's own unclean hands.

[THIS SPACE INTENTIONALLY LEFT BLANK]

WHEREFORE, Opposer, Rita M. Clark d/b/a Bluewater Rentals., respectfully requests that this Court dismiss Applicant's Counterclaim with prejudice.

Dated: May 23, 2013

Respectfully submitted,

/s/ Kevin Markow
KEVIN MARKOW, ESQ.
Florida Bar No. 66982
MICHAEL DE BIASE, ESQ.
Florida Bar No. 076205
BECKER & POLIAKOFF, P.A.
3111 Stirling Road
Fort Lauderdale, FL 33312-6525
Telephone: (954) 987-7550
Facsimile: (954) 985-4176
KMarkow@becker-poliakoff.com
MDeBiase@becker-poliakoff.com
Attorneys for Applicant

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on May 23, 2013, the undersigned electronically filed this document with the Trademark Trial and Appeal Board, and has caused a true and correct copy of this Notice of Opposition to be served via email and first class mail, postage prepaid, to:

Arlen Olsen
Schmeiser, Olsen & Watts, LLP
22 Century Hill Drive, Suite 302
Latham, NY 12110
aolsen@iplawusa.com

with a hard copy only (no email) to:

Bluewater Key RV Ownership Park
Property Owners Association, Inc.
2950 US Highway 1
Key West, Florida 33040

/s/ Kevin Markow
KEVIN MARKOW, ESQ.

ACTIVE: 4742587_1